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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/634,333

08/04/2003

Guenter Berschel

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09/21/2006

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LEGAL PATENT RECORDS CENTER
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EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary	Application No.	Applicant(s)	
	10/634,333	BERSCHEL ET AL.	
	Examiner	Art Unit	
	Elena Tsoy	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Amendment

2. Amendment filed on 8/22/2006 has been entered. Claims 1, 3-6, 9, 11 are pending in the application.

Claim Objections

3. Objection to claims 1, 3, 4, and 6 because of the informalities has been withdrawn due to amendment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Rejection of claims 1, 3-5, 9, 11 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dattilo (US 6,291,018) and incorporated by reference Backhouse (US 4,220,679) has been withdrawn due to amendment.

7. Rejection of claims 1, 3, 9, 11 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Anderson et al (US 6,592,999) has been withdrawn due to amendment.

The Examiner Note: the recitation of *refinishing* has not been given patentable weight because the recitation occurs in the preamble, which merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural

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limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

8. Claims 1, 3-6, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kasari et al (US 6,165,621) in view of in view of Thomas (US 5869566).

Kasari et al disclose a method of forming a 3-coat system for automotive applications (See column 1, lines 14-15) comprising the steps of applying the coating compositions (A), (B) and (C) in this order to a metal substrate; (A) an **organic solvent**-based thermosetting metallic first base coating composition which comprises a *metallic* pigment, (B) an **aqueous** thermosetting second base coating composition which comprises a *metallic* pigment or a coloring pigment (See column 9, lines 50-51), and (C) an organic solvent-based thermosetting clear coating composition (See column 1, lines 56-67 to column 2, lines 1-6). The clear coating composition (C) is a thermosetting composition comprising a base resin preferably hydroxyl-containing acrylic resin (See column 10, lines 31-32), a crosslinking agent preferably amino resin (See column 11, lines 15-16) and an organic solvent (See column 10, lines 27-30).

Kasari et al fail to teach that a solvent based clear coat composition containing hydroxyl containing film forming material and polyisocyanate crosslinking agents that cures at ambient temperature or in the range of 40⁰C to 60⁰C is used as a clear thermosetting composition, as required by Amended claim 1.

Thomas teaches a solvent based clear coat coating composition (See column 5, lines 47-60) containing hydroxyl group-containing polymer and a polyisocyanate curing agent (See column 2, lines 17-25) that cures under ambient conditions or at slightly elevated temperatures by heating to a temperature ranging from about 30⁰C to about 60⁰C (See column 6, lines 1-10) and exhibits in addition to good adhesion and rapid drying, excellent appearance and physical properties including gloss, hardness, and distinctness of image that makes the composition particularly useful as an automotive refinish coating (See column 6, lines 11-15). The coating compositions are typically applied by *spray* application (See column 6, line 1). The coating composition is typically applied as a clear topcoat over a pigmented basecoat, including a variety of conventionally known basecoats (See column 6, lines 2-5). Thomas further teaches that although the coating compositions are preferably clear coating compositions which can be used as a **clear topcoat** over

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a **pigmented basecoat**, the coating compositions can also be pigmented with a variety of pigments and utilized as a colored basecoat or topcoat, without a clearcoat (See column 5, lines 33-38).

Alternatively, the coating compositions can be used as primers if desired (See column 5, lines 39-40). A variety of pigments well known to those skilled in the art can be used including inorganic pigments such as titanium dioxide, silica, iron oxide, talc, mica, carbon black, and zinc oxide (See column 5, lines 39-43). In addition, metallic pigments such as aluminum flake and **metallic effect pigments** such as the pearlescent pigments available from Mearl Corp. can be used (See column 5, lines 43-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a solvent based clear coat composition of Thomas containing hydroxyl group-containing polymer and a polyisocyanate curing agent that cures at ambient temperature or in the range of 40⁰C to 60⁰C as a top clear coat in Kasari et al with the expectation of providing the desired good adhesion and rapid drying, excellent appearance and physical properties including gloss, hardness, and distinctness of image, as taught by Thomas.

9. Claims 1, 3-6, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moy (US 5578345) in view of Kasari et al.

Moy discloses a method of forming a multi-layer color-plus-clearcoating system for automotive applications (See column 1, lines 11-21) comprising applying a first and second coats either pigmented or unpigmented (See column 2, lines 37-67). In a preferred embodiment, the first coat is a pigmented basecoat suitable for use in automotive coating applications under an unpigmented clearcoat (See column 2, lines 53-56). The second coat can be the pigmented basecoat (if the primer is the first coat), but is an **unpigmented clearcoat** (wherein the basecoat is the first coat) in a preferred embodiment (See column 2, lines 62-65). The first coat composition may be *any* of the polymers known to be useful in coating compositions including the polymers and/or diluent compositions of this invention (See column 3, lines 6-8). *Either solvent based or water-reducible* first and second coats can be used in combination with the materials of the invention (See column 3, lines 9-11). Typically, the first coat will include pigments and colorants *conventionally* used for coating compositions and after being applied to a substrate (See column 4, lines 47-50) such as solid color pigments or metallic pigments (See column 6, lines 24-32). The second coat must contain an active hydrogen functional component such as hydroxyl (See column

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4, lines 27-36) and an isocyanate functional material such as polyisocyanates (See column 5, lines 50-67). If desired, multiple layers of first and/or second coat can be applied (See column 6, lines 9-11), for example, a primer, two basecoats and a clear coat (See column 9, lines 4-17). All coating are air dried (claimed curing at ambient temperature) (See column 10, lines 18-35).

Moy does not expressly teach that the first basecoat is organic solvent based and contains a solid pigment, the second basecoat is water based (Claim 1) and contains either metallic pigment (Claim 3) or solid color pigment (Claim 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used any combination of solvent based and water-reducible first and second basecoats including claimed combination for forming a multilayer coating in Moy because Moy does not limit his teaching to a particular combination.

Kasari et al teach that a multilayer coating for *automobiles* (See column 1, lines 6-12) can be prepared by applying **aqueous basecoat B** containing a metallic or coloring pigment (See column 9, lines 50-51) to a **solvent-based basecoat A** containing a metallic pigment followed by applying an organic solvent-based thermosetting clear coating composition C (See column 1, lines 56-67 to column 2, lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a water based first basecoat and a solvent based second basecoat in Moy since Kasari et al teach that a multilayer coating for automobiles can be prepared by applying aqueous basecoat containing a metallic or coloring pigment to a solvent-based basecoat containing a metallic pigment followed by applying an organic solvent-based thermosetting clear coating composition.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used any combination of pigmented basecoat layers including claimed combination for forming a multilayer coating in Moy because Moy does not limit his teaching to a particular combination.

10. Claims 1, 3-5, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dattilo in view of Kasari et al, further in view of Thomas (US 5869566).

Dattilo is applied here for the same reasons as set forth in paragraph 6 of the Office Action mailed on 5/19/2006. Dattilo further teaches that the first and second basecoat materials are liquid

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waterborne or organic solvent based coating materials (See column 6, lines 8-20). Preferably, a clearcoat material is a crosslinkable coating comprising at least one thermosettable film-forming material and at least one crosslinking material (See column 10, lines 4-7). The clearcoat may be waterborne (See column 10, line 21) or organic solvent based compositions (See column 10, line 24) that comprise the same film forming material and a cross-linking agent as the first and second basecoat materials (See column 10, lines 3-7), e.g. hydroxyl containing film forming material (See column 4, lines 29-33-34, 43-52) and polyisocyanate crosslinking agents (See column 4, lines 62-63). In other words, the first basecoat, the second basecoat and clearcoat may be of the same composition except for pigments. Dattilo does not limit the coatings to specific compositions or specific combinations of water based and solvent based coating compositions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used any combination of solvent based and water-reducible first and second basecoats including claimed combination for forming a multilayer coating in Dattilo because Dattilo does not limit his teaching to a particular combination.

Kasari et al are applied here for the same reasons as above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a water based first basecoat and a solvent based second basecoat in Dattilo since Kasari et al teach that a multilayer coating for automobiles can be prepared by applying aqueous basecoat containing a metallic or coloring pigment to a solvent-based basecoat containing a metallic pigment followed by applying an organic solvent-based thermosetting clear coating composition.

Dattilo does not teach a solvent based clear coat composition containing hydroxyl containing film forming material and polyisocyanate crosslinking agents that cures at ambient temperature or in the range of 40⁰C to 60⁰C, as required by Amended claim 1.

Thomas is applied here for the same reasons as above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a solvent based clear coat composition of Thomas containing hydroxyl group-containing polymer and a polyisocyanate curing agent that cures at ambient temperature or in the range of 40⁰C to 60⁰C as a top clear coat in Dattilo with the expectation of providing the desired good adhesion and rapid drying, excellent appearance and physical properties including gloss, hardness, and distinctness of image, as taught by Thomas.

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11. Claims 1, 3-5, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kasari et al/Moy in view of Kasari et al/, further in view of Dattilo.

Kasari et al/Moy in view of Kasari et al/ are applied here for the same reasons as above. Kasari et al/Moy in view of Kasari et al/ do not expressly teach that the first organic solvent based basecoat contains a solid pigment, the second water based basecoat contains metallic pigment (Claim 3).

Dattilo teaches that solvent based and water-reducible basecoats in any combination may be used for forming a first and a second basecoat (See column 6, lines 8-20). When a first basecoat contains a solid color pigment and a second basecoat contains metallic effect pigment, a composite coating has a polychromatic effect (See claims 1-5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed a multilayer coating in Kasari et al/Moy in view of Kasari et al/ from a first layer containing a solid color pigment and a second basecoat containing metallic effect pigment, with the expectation of providing the desired polychromatic effect, as taught by Dattilo.

12. Claims 1, 3-5, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (US 6,592,999) in view of Thomas.

Anderson et al are applied here for the same reasons as set forth in paragraph 7 of the Office Action mailed on 5/19/2006. Anderson et al teach that the *topcoat* (clearcoat) can include **any** of the crosslinkable coating compositions comprising at least one thermosettable coating material and at least one curing agent such as *waterborne* clearcoats, *solvent borne* clearcoats and *powder* clearcoats (See column 36, lines 44-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used any combination of solvent based and water-reducible first and second basecoats including claimed combination for forming a multilayer coating in Anderson et al because Anderson et al do not limit their teaching to a particular combination.

Anderson et al fail to teach that a clear coat composition contains hydroxyl containing film forming material and polyisocyanate crosslinking agents that cures at ambient temperature or in the range of 40⁰C to 60⁰C, as required by Amended claim 1. Thomas is applied here for the same reasons as above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a solvent based clear coat composition of Thomas containing hydroxyl group-containing polymer and a polyisocyanate curing agent that cures at ambient temperature or in the range of 40⁰C to 60⁰C as a top clear coat in Anderson et al with the expectation of providing the desired good adhesion and rapid drying, excellent appearance and physical properties including gloss, hardness, and distinctness of image, as taught by Thomas.

13. Claims 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al Anderson et al in view of Thomas, and further in view of Kubitza et al (US 5075370) and Briselli et al (US 5,466,286) for the reasons of record set forth in paragraph 9 of the Office Action mailed on 7/26/2005.

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al Anderson et al in view of Thomas, further view of Kubitza et al and Briselli et al, and further in view of Schlaak (US 5,976,343) for the reasons of record set forth in paragraph 10 of the Office Action mailed on 7/26/2005.

Response to Arguments

15. Applicant's arguments with respect to claims 1, 3-6, 9, and 11 have been considered but are moot in view of the new ground(s) of rejection.

As to Dattilo, Applicants submit that: (i) Dattilo clearly points out the limitation and the problem in NOT being able to use a solvent-borne basecoat AN[:]) a water-borne basecoat on top of each other. Applicants believe that the word "preferably" used in Dattilo, in this particular context, means that Dattilo uses: (1) two basecoats, BOTH of which are water-borne; or (2) two basecoats, BOTH of which are solvent-borne. And the word "preferably" indicates Dattilo's inclination or preference to use a "two basecoats, both water-borne" system over "two basecoats, both solvent-borne" system.

However, in contrast to Applicants statement, **nowhere** Dattilo clearly points out the limitation and the problem in NOT being able to use a solvent-borne basecoat AN[:]) a water-borne basecoat on top of each other. Furthermore, "Preferably" can be interpreted only that other combinations are not preferred but possible.

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(ii) Dattilo does not teach a solvent-borne basecoat AND a water-borne basecoat within the context of the above discussion. Dattilo expressly states that its first basecoat and the second basecoat are similar except for the presence of the pigment in the second basecoat. For example, in Col. 15, Example 1, Dattilo teaches using a first basecoat, which is a water-borne basecoat DHWB 74101 from PPG Industries, without the metallic effect pigment, and the second basecoat is the same water-borne basecoat DHWB 74101 from PPG Industries, WITH the mica flake and aluminum flake effect pigments (See Col. 15, lines 20-25).

The Examiner disagrees. It is held that patents are relevant as prior art for all they contain. See *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). **NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments.** See MPEP 2123. Therefore, disclosed Example 1 of Dattilo does not teach away from a broader teaching that a first and second basecoats could be either water based or solvent based, and nowhere Dattilo teaches that water based basecoat cannot be combined with a solvent based layer.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

September 20, 2006

ELENA TSOY
PRIMARY EXAMINER
E Tsoy